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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/556,124

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Roland Wagner

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EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/556,124	<b>Applicant(s)</b> WAGNER ET AL.	
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/4/10 Amendment.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14-28 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-28 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The Applicants' amendment filed February 4, 2010 is acknowledged. Claims 13 and 29-30 are deleted. Claims 1, 7-8, 11-12, 15 and 20 are amended. Claim 33 is added. Now, Claims 1-12, 14-28 and 31-33 are pending.
2. Claim objection(s) in the previous Office Action (Paper No. 20091107) is/are removed.
3. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 20091107) is/are removed.
4. Claim rejection(s) under 35 USC 103 in the previous Office Action (Paper No. 20091107) is/are removed.
5. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

### ***Specification***

6. The disclosure is objected to because of the following informalities:

Applicants are advised to a) include Brief Description of the Drawing in the specification, and b) remove the Figure in page 69 and present the figure in a separate page.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. Claims 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 7 (page 5), should “or” before “a tetravalent radical of the formula” be -- and --?

In Claim 8 (lines 3-4), should “exclusive of the polyorganosiloxane radical” be -- exclusive of the carbon atoms of the polysiloxane radical -- as indicated in a similar expression in Claim 33?

In Claim 8 (page 6, line 10), it is not clear as to what “ $\overset{|}{\text{---N---}}$  and may contain polyorganosiloxane radicals” refers to.

In Claim 15 (line 7), after “modifiers,”, should there be -- and --?

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, Claim 33 recites the broad recitation “an optionally substituted heterocyclic group” (page 10, line 3), and the claim also recites “preferably containing one ....and polyetherester radicals” (page 10, lines 4-5) which is the narrower statement of the range/limitation.

In Claim 33 (page 10, line 7), it is not clear as to what “-C(O)- and

-C(S)- refers to.

In Claim 33 (page 10, line 14), after “-CONH-“, should there be -- and --?

### ***Claim Rejections - 35 USC § 103***

8. Claims 1-12, 14-28 and 31-33 are rejected under 35 USC 103(a) as being unpatentable over Zhang (US 2003 0096728).

For Claims 1-3, 6-12, 14-17, 19-28 and 33, Zhang discloses a polyorganosiloxane composition comprising a cationic silicone polymer or copolymer having the formula  $[CAP]-Z_m-[CAP]$  containing secondary, tertiary or quaternary amino moiety or mixtures thereof for treating fabrics. ([0007]-[0019] and [0068]-[0149]) The cationic silicone polymer or copolymer can be those corresponding to presently claimed amino and/or ammonium-polysiloxane compound a1) and amino and/or ammonium-polysiloxane compound a2). ([0152]-[0155]) Zhang is silent on the employment of a mixture of these two types of compounds. However, the court held, "[i]t is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he

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idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) The composition can be further illustrated in [0235]-[0245], where a carrier substance and other additives can be employed. For Claim 4, as discussed above, it would have been obvious to utilize a mixture of the two types of cationic silicone polymers or copolymers. In other words, each type of the cationic silicone polymer or copolymer can be present in the foregoing mixture of from greater than 0% to less than 100%. Zhang is silent on the presently claimed weight ratio, i.e., the amounts of compound a1) and compound a2) can be 97% wt and 3% wt, respectively, or 1% wt and 99% wt, respectively, or relative amounts somewhere in between. However, Examiner notes that Zhang that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a *prima facie* case of obviousness. *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). For Claims 5 and 31, Examiner's position set forth above is applicable here in a similar manner. For Claim 18, a nonionic surfactant can be used. ([0248]) For Claim 32, it would have been obvious to one of ordinary skill in the art

to utilize the two types of cationic silicone polymer or copolymer in equal amounts absence of the preference of either component.

For Applicants' argument (Remarks, page 15, last paragraph bridging to page 16, 1<sup>st</sup> paragraph), Applicants' assertion is moot in view of the new ground of rejection, *supra*.

For Applicants' argument (Remarks, page 16, last paragraph bridging to page 17, 1<sup>st</sup> paragraph), Examiner disagrees. The alleged unexpected results of combining the presently claimed two types of siloxane softeners are not persuasive. After carefully considering the results described in Table 2 of the specification, *inter alia*, Examples 9-12 do not unequivocally demonstrate the asserted advantage over the comparative Examples, at best, the comparison is inconclusive.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the



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organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
April 30, 2010

/Kuo-Liang Peng/  
Primary Examiner, Art Unit 1796